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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,063

03/19/2004

William P. Henson

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7919

35602

7590

09/21/2007

Stephen C. Glazier

Kirkpatrick & Lockhart Preston Gates & Ellis LLP

1601 K Street, N.W.

Washington, DC 20006-1600

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

09/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/805,063

Applicant(s)

HENSON ET AL.

Examiner

Dan Kesack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,25,26,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,25,26,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Amendment filed May 17, 2007 has been entered and fully considered. Claims 1-7, 25, 26, 30, and 31 are currently pending. The rejections are as stated below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Amended claims 1 and 25 recite "negotiating terms for obtaining a revenue share interest in the business. However, the specification fails to mention any negotiations taking place between any parties. The remarks filed May 17, 2007 detail that "support for the claim amendments... may be found throughout the specification," however Examiner was unable to locate such support.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 4, 25, 26, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman, U.S. Patent No. 7,149,719, as cited in the previous Office Action.

Claims 1, 25, Schulman inherently teaches the newly added limitation of "negotiating terms for obtaining a revenue share interest in the business". In light of the rejection under 35 U.S.C. 112, first paragraph, above, the negotiation of terms is necessarily performed according to the teachings of Schulman. Schulman teaches standard forms and terms which disclose the appropriate functions for determining how the capital contributions are to relate to the return of future gross sales/revenues (column 3 line 52 – column 4 line 3). The agreement between the parties, which is

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detailed in the standard forms and terms essentially make up a contract between the two parties. The terms must be decided upon by the issuer in order for the standard terms and forms to be created. Synonyms for negotiate include contract, deal, make terms, and transact. As such, Schulman inherently teaches negotiating the terms.

Claims 30, 31, Schulman teaches the negotiated terms include a fixed expiration date (abstract - "a specified period of time").

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman, in view of Adams, U.S. Patent No. 6,154,730, as cited in the previous Office Action.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman, in view of Freund, U.S. Patent Application Publication No. 2004/0024671, as cited in the previous Office Action.

***Response to Arguments***

9. Applicant's arguments filed May 17, 2007 have been fully considered but they are not persuasive. Applicant argues that Schulman teaches away from "negotiating terms for obtaining a revenue share interest in the asset management firm." Examiner respectfully disagrees, in that Examiner is of the opinion that Applicants arguments give the word "negotiating" a very specific definition which is not supported by Applicant's specification (see 35 U.S.C. 112, first paragraph rejection, above). While Examiner recognizes Schulman recites "the terms are non-negotiable," this is only after the formation of the contract which becomes a standard product to be publicly traded. The terms of any agreement, such as the one defined by the financial product of Schulman, must be negotiated in some way in order to create the financial product. Accordingly, the terms of Applicant's contract are also non-negotiable after the terms are decided upon by one or more parties. The fact that the terms of Schulman are standard and non-negotiable once the product is created and traded does not mean that Schulman teaches away from all negotiation of terms. To the contrary, given its broadest reasonable interpretation, negotiation must necessarily take place at some point in order to create the product.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack

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September 12, 2007



HANI M. KAZIMI  
PRIMARY EXAMINER